

Remarks

Applicant respectfully submits the following Remarks and favorable consideration thereof is earnestly requested.

The Examiner has variously rejected all the pending claims either in whole or in part over U.S. Published Patent Application No. 2003/0021442 (Suzaki). Applicant submitted a Declaration of Inventor under 37 CFR 1.131 (the "Declaration") stating that the invention was invented at least as early as April 2002. In response to the filing of the Declaration, the examiner issued an Advisory Action stating,

The affidavit filed on 07 April 2011 under 37 CFR 1.131 has been considered but is ineffective to overcome the Suzuki (US 2003/0021442) reference . . . The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Suzuki (US 2003/0021442) reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended . . . The affidavit filed on 07 April 2011 fails to disclose enough to show conception at the date mentioned since conception is more than just a vague idea, but must show complete disclosure to another.

Advisory Action, 4/22/11 p. 2.

Claim 1 recites a "document security system for printing secured documents comprising: a digital file accessible by a receiver via a terminal; a printer connected to the terminal; security data specific to each page of said digital file; a printed file printed by said printer corresponding to said digital file; a mark printed by said printer on each page of the printed file, said mark containing data unique to each page of the printed file; wherein said mark printed on each page of the printed file comprises covert data; wherein reproduction of the printed file as an authenticable printed file is prevented by means of the mark containing data unique to each page of the printed file."

Applicant respectfully submits that all of these limitations are disclosed in the invention disclosure entitled "Secure Document Printing" attached at B to the Declaration. For example, the Invention Disclosure states, "This invention relates to the problem of verification that a document is indeed the one intended." Accordingly, the invention disclosure highlights the problem of document verification. The invention disclosure goes on to state,

It develops from the integration of a digitally secure document with a targeted digitally secure printer that will mark the document and only that one document in such a way that one can prove that it is the intended document and a copy or a modified document.

Computers are used to originate or process nearly every document in use. The computer file has been developed to the stage that security features can keep the information "safe" from the origination to storage to delivery in the digital format. Newly developed input control and certification techniques such as finger-print entry pads to a pc, can assure the next user of the true parties identification at place of origination. The information may be acted on only in digital format. If so, the process is complete. However, many documents are printed for action or [sic] for record keeping or for reading later. These printings of the document are more and more likely to be in some remote location. The object of this invention is to make a printer that can be addressed and linked to the document source with intelligence to carry the security encryption/certification through to print the file. The printer might be arranged to only print if the file is from a selected source, only if it has not been opened, print only once, and with a security mark that can be forensically validated as a true and unblemished copy.

Unique components of this invention:

To accomplish the goal:

The printer must accessible only by the approved party. The same entry system (such as a fingerprint keypad) as is used for the originator to design or type the document is also applied to the printer.

The printer must be able to distinguish the certification details of the digital file and be activated (the special features activated) by the acceptable code/signal.

The printer must be able to print a mark that can be measurably provably unique.

The printer would either be the same as the primary message printer or else integrated into that printer so that the unique mark is placed on the page as the message is printed. It can be covert or overt or both. It will effectively watermark that paper as it is printed to provide the same anticounterfeiting advantage of watermarks and other features usually marked at a production factory.

The mark must be unique to this file and to this page of paper. It must be printed in such a way that it can not be copied and has a unique (unique to that individual page) number or code.

The paper may have some other features built in before the printing to avoid tampering later.

Existing technology can be applied to create the desired results.

1. Entry control to the digital origination. Several
2. Encryption and Certification. Several
3. Printer access control: Several – same as first step
4. Selective printer activation – Several – same as digital document certification
5. Digital marker to “print” watermark – several – inkjet with dyes, DNA, (covert or overt); Thermal Transfer holographic foil.

Invention Disclosure, pp. 1-2.

Accordingly, the Invention Disclosure discloses at the very least, the following information:

“document security system for printing secured documents” (*invention relates to the problem of verification that a document is indeed the one intended*)

“digital file accessible by a receiver via a terminal” and “a printer connected to the terminal” (*integration of a digitally secure document with a targeted digitally secure printer that will mark the document*)

“security data specific to each page of said digital file” (*mark must be unique to this file and to this page of paper*)

"a printed file printed by said printer corresponding to said digital file" (object of this invention is to make a printer that can be addressed and linked to the document source with intelligence to carry the security encryption/certification through to print the file)

"a mark printed by said printer on each page of the printed file, said mark containing data unique to each page of the printed file" (mark must be unique to this file and to this page of paper. It must be printed in such a way that it can not be copied and has a unique (unique to that individual page) number or code)

"wherein said mark printed on each page of the printed file comprises covert data" (Digital marker to "print" watermark – several – inkjet with dyes, DNA, (covert or overt); Thermal Transfer holographic foil . . . the unique mark is placed on the page as the message is printed. It can be covert or overt or both)

"wherein reproduction of the printed file as an authenticable printed file is prevented by means of the mark containing data unique to each page of the printed file" (a digitally secure document with a targeted digitally secure printer that will mark the document and only that one document in such a way that one can prove that it is the intended document and a copy or a modified document . . . printer might be arranged to . . . print only once, and with a security mark that can be forensically validated as a true and unblemished copy . . . printer must be able to print a mark that can be measurably provably unique)

Based on the forgoing, Applicant respectfully submits that the Declaration shows conception of the complete claimed invention at the date mentioned, and is not a "vague idea" as all the claim elements are explicitly disclosed.

Applicant respectfully submits 37 CFR 1.131(a) states, in part,

When any claim of an application . . . is rejected, the inventor of the subject matter of the rejected claim . . . may submit an appropriate oath or declaration to es-

tablish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

37 CFR 1.131(b) states, in part,

The showing of facts shall be such, in character and weight, as to establish . . . conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to . . . the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration.

Applicant respectfully submits that the Declaration complies with 37 CFR 1.131(a) and (b) in all respects and therefore should not be rejected. It is further respectfully submitted that claims 1-8, 10-19, 21-24, 26-28, 30 and 32 are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

/Wesley W. Whitmyer, Jr./

June 7, 2011

Wesley W. Whitmyer, Jr., Registration No. 33,558
Steven B. Simonis, Registration No. 54,449
Attorneys for Applicant
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
Tel. 203 324-6155